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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,832	06/21/2001	Toshikazu Hirota	789 070	6274

25191 7590 08/14/2002

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EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 08/14/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/868,832

Applicant(s)

HIROTA ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-32.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE:

The amendments will not be entered because the amendments merely incorporate the limitations of Claims 8, 10 and 12 into Claims 1, 3 and 5 respectively. Claims 8, 10 and 12 stand rejected under 35 U.S.C. 1-2 (e) as anticipated by Felder et al. Therefore, incorporation of the limitations of Claims 8, 10 and 12 do not place the claims in condition for allowance nor reduce or simplify the issues for appeal.


Applicant argues that Felder does not disclose a plurality of sample spots arranged on a base plate having different spot sizes as recited in Claim 1 because in contrast to the instant invention, Felder varies the size of the support (i.e. beads and particles) but does not vary the size of the spots. The argument has been considered but is not found persuasive because as explained during the interview with Mr. Caldwell, the beads are encompassed by the by the broadly claimed "sample spots". The claims are drawn to a biochip comprising a large number of spots containing capture solutions arranged on a base plate. Felder discloses a biochip comprising a large number of containing capture solutions arranged on a base plate is a spot formation (see for example Fig. 10, 12 and 13) and they disclose the capture solutions are attached to beads are of different size (Column 8, lines 52-56). Therefore, Felder discloses the biochip as claimed.

Applicant argues that Felder distinguishes between the spots formed on the support and the beads/particles carried by the support and as such, the skilled artisan would not and could not understand that Felder's beads are spots having different size. The argument has been considered but is not found persuasive for the reasons stated above. Additionally, while Felder distinguishes between the spots on the support (wells) and the beads/particles, both the wells and beads/particles are encompassed by the claimed "spots" as is clearly illustrated in Fig. 10, 12 and 13).

Regarding Claim 3, Applicant argues that the sample well of Felder is not a spot and therefore Felder does not disclose the claimed invention. The argument has been considered but is not found persuasive for the reasons stated above, for the reasons stated in the interview with Mr. Caldwell and for the reasons stated in the final office action. The wells of Felder are encompassed by the claimed spots. The support of Felder comprises wells (spots) which further comprise spots (e.g. see spots within the well-spots of Fig. 10, 12, and 13). The figures clearly illustrate the spots within the well spots. As such, the wells of Felder are encompassed by the claimed spots. Hence, Felder discloses the claimed invention. Applicant seems to be arguing that because Felder dispenses spots within the wells (Column 30, lines 30-32) and distinguishes between the wells and the spots that the wells cannot also be "spots". However, as stated above, Fig. 10, 12 and 13 clearly illustrate that the 10-nanoliter droplets within the wells produces spots within spots.

Regarding Claim 5, Applicant argues that Felder's DNA-bind coated wells does not provide a first layer spot because their sample well is not adapted to specifically react with a specimen and provide information about a structure within the specimen. The argument has been considered but is not found persuasive because as Applicant acknowledges, the DNA-bind coated wells adapts the wells to specifically react with (attach) DNA and a DNA-DNA bind reaction provides information regarding the presence of DNA.

Regarding Claim 33, the arguments have been considered but are deemed moot in view of the fact that the amendments have not been entered. Additionally, arguments regarding "wherein both the first and second layer spots specifically reaction with a specimen and provide information about a structure within the specimen" is not relevant to Claim 33 which does not recite this limitation. This limitation, if added to the claims, potentially introduces new matter. If Applicant adds this limitation to Claim 33, it is suggested that Applicant point to support in the specification for this limitation. Fig. 17 merely illustrates shapes of spots but does not provide support for the argued limitation.


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Technology Center 1600